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10/553,793	10/18/2005	Xu He	279307US0PCT	6091
22850	7590	08/03/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			EGWIM, KELECHI CHIDI	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1796	
NOTIFICATION DATE	DELIVERY MODE			
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Mailed : **AUG 03 2009**  
In re Application of  
Xu He, et al.  
Serial No. 10/553,793  
Filed: October 18, 2005  
For: Polymer Dispersion With A Colour Effect

**DECISION ON  
PETITION**

This is a decision on the PETITION filed on May 21, 2009 UNDER 37 CFR 1.181 and 1.183 petitioning Examiner's withdrawal of claims 11-16, 21 and 25 from consideration in the office action mailed on April 16, 2009.

Applicants filed an amendment on December 19, 2008. The Examiner determined that newly amended claims 11-16, 21 and 25 were directed to an invention that was independent or distinct from the original invention. The Examiner stated that the present intermediate process and product to be deemed separately useful as coating film and the inventions were deemed to be patentably distinct because there is nothing of record to show them to be obvious variants (MPEP 806.05(j)).

Applicants assert that amended claim 11 is not independent and not distinct from original claim 11.

A review of the application indicates that application was filed under 37 CFR 371. The proper standard to apply should be unity of invention whereby an application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1).

With respect to a group of inventions claimed in an application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step.

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant.

The Examiner did not do a determination of "unity of invention" for the newly amended claims before withdrawing the claims from consideration.

## **DECISION**

The petition is **GRANTED**.

The Examiner is directed to issue a new office action incorporating the claims that were withdrawn from consideration. If upon consideration, the Examiner feels that a lack of unity of invention exists with the newly amended claims, the Examiner should clearly demonstrate this in the new office action and may then consider withdrawing the claims from consideration.

/Gregory L Mills/

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